

REMARKS

By the present Amendment, Applicant has amended claims 9, 12, and 21 to more appropriately define the present invention. Specifically, among other things, Applicants advise that claim 9 has been amended to correct a typographical error by which the phrase "light exposure apparatus" has been replaced with "exposure apparatus." Applicant submits that in making each of the amendments, no new matter has been added. As a result of this Amendment, claims 1-21 are pending.

Applicant wishes to thank Examiner Cruz and Examiner Adams for allowing Applicant's representatives to discuss pending claims 1-21 during a personal interview on January 22, 2004. The substance of the interview is summarize as follows:

Applicant's representatives pointed out the deficiencies of the cited references with respect to the claimed invention. Specifically, the Examiners agreed with the Applicant's argument that Hayashi (U.S. Patent No. 5,015,866) does not disclose the correction of the defect of the substrate as recited in claims 1, 9, and 18. Further, a proposed amendment to claim 21 was discussed and the Examiners agreed that the proposed amendment to claim 21 would overcome the rejection of that claim under 35 U.S.C. § 112, second paragraph. Applicant has amended claim 21 in accordance with the proposed amendment as discussed during the interview.

In reply to the Office Action dated September 16, 2003, Applicant respectfully requests reconsideration of the above-identified application based on the following remarks.

In the Office Action, the Examiner objected to claim 21 because of minor informalities; rejected claim 21 under 35 U.S.C. § 112, second paragraph; and rejected claims 1-10 and 13-20 as being unpatentable over Hayashi. Further, the Examiner

objected to claims 11 and 12 as being dependent upon a rejected base claim but indicated their allowability if rewritten in independent form. Applicant appreciates the indication of allowable subject matter in this application.

Objection to claim 21

In response to the Examiner's objection, Applicant has amended claim 21 by replacing the phrase "be a defect" with "is a defect;" replaced the phrase "reflective pattern" with "a reflective pattern;" replaced the phrase "be a defect" with "is a defect;" replaced the phrase "reflective pattern" with "the reflective pattern;" replaced the phrase "located surface" with "located on the surface;" replaced the phrase "reflective pattern" with "a reflective pattern portion;" and replaced the phrase "be repaired" with "is repaired." Accordingly, Applicant respectfully requests the Examiner to withdraw the objection to claim 21 and the claim allowed.

Rejection under 35 U.S.C. § 112, second paragraph

On pages 5-6 of the Office Action, the Examiner rejected claim 21 under 35 U.S.C. § 112, second paragraph for being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention.

Applicant's representatives discussed a proposed amendment to claim 21 with Examiner Cruz and Examiner Adams during the interview and the Examiners indicated that the proposed amendment to claim 21 would overcome the rejection under 35 U.S.C. § 112, second paragraph. Applicant has amended claim 21 in accordance with the proposed amendment discussed during the interview. Accordingly, Applicant deems the rejection of the present claim 21 under 35 U.S.C. § 112, second paragraph overcome, and respectfully requests the Examiner to allow claim 21.

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Rejection under 35 U.S.C. § 103(a)

On pages 6-13 of the Office Action, the Examiner rejected claims 1-10 and 13-20 under 35 U.S.C. § 103(a) as being unpatentable over Hayashi. Applicant traverses the rejection of claims 1-10 and 13-20 under 35 U.S.C. § 103(a) because the Examiner has failed to make a *prima facie* case of obviousness for claims 1-10 and 13-20.

Independent claim 1 recites a pattern forming method comprising, among other things, "detecting a defect ... analyzing the mutual positional relationship between the detected defect and a pattern to be formed on [a] substrate surface; and based on the result of the analysis, correcting the pattern position in the step of pattern exposing on to said substrate surface in said pattern."

As discussed during the interview on January 22, 2004 with Examiner Cruz and Examiner Adams, Hayashi fails to teach or suggest each and every element of claim 1. At least because Hayashi does not teach or suggest each and every element of claim 1, the rejection of claim 1 under 35 U.S.C. § 103(a) is improper. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claim 1 under 35 U.S.C. § 103(a) and the claim allowed. Applicant submits that claims 2-8 are also allowable at least in view of their dependency, directly or indirectly, from allowable claim 1.

Present independent claims 9 and 18 contain recitations similar to allowable claim 1. At least for the reasons discussed above, Hayashi does not teach or suggest each and every element of claims 9 and 18 and therefore, the rejection of claims 9 and 18 under 35 U.S.C. § 103(a) is improper. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a) and the

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claims allowed. Applicant submits that claims 10, 14-17, 19-21 are also allowable at least in view of their dependency, directly or indirectly, from allowable claims 9 and 18.


In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: February 17, 2004

By:  Reg 24,014
for Richard V. Burgujian
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